



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/813,863 | 03/31/2004 | Edward Vaquero | P03166 | 5586 |
| 23702 | 7590 | 06/06/2007 | | |
| Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701 | | | EXAMINER LANG, AMY T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3731 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 06/06/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,863

Applicant(s)

VAQUERO, EDWARD

Examiner

Amy T. Lang

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 3/27/2007. In particular, claim 1. This combination of limitations was not present in the original claims. Thus, the following action is properly made final.

All previous rejections and objections not included in this office action have been withdrawn in light of applicant's amendments filed 3/27/2007.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

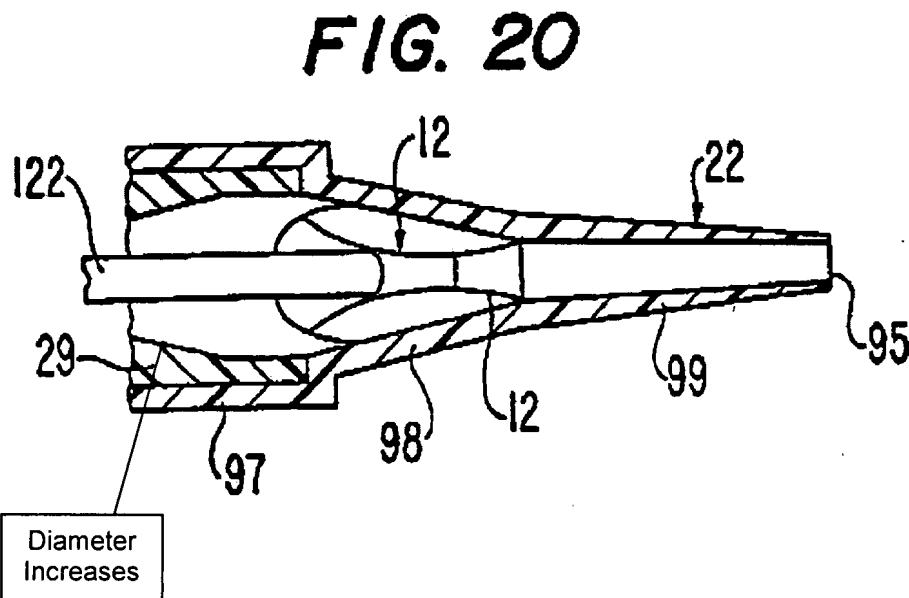
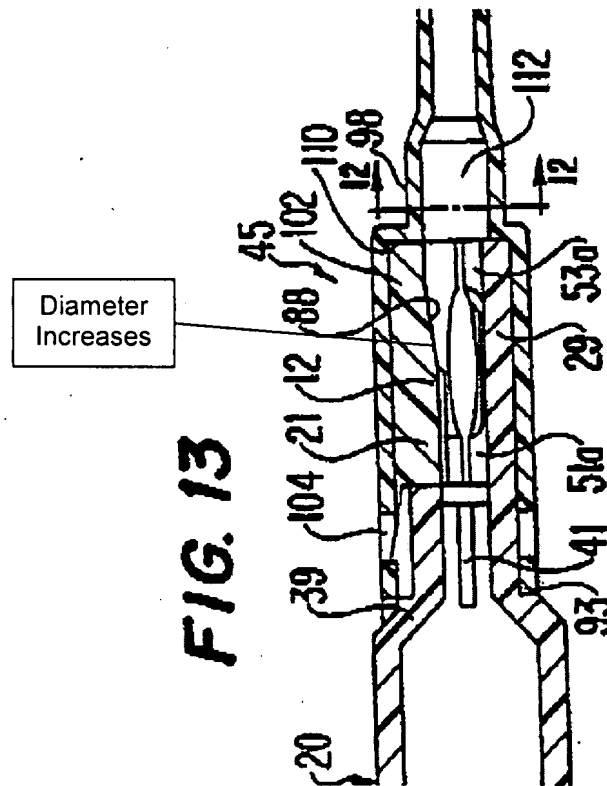
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 3-6, 8, and 10** are rejected under 35 U.S.C. 102(b) as being anticipated by Figueroa (US 2002/0022881 A1).

With regard to **claim 1**, Figueroa discloses a device for injecting a foldable IOL into an eye ([0006]). The device comprises body (16) and lumen (24), wherein the lumen terminates in a distal opening (95) (Figure 13). Shelf segment (29) defines an opening in the body between the proximal and distal ends of the device ([0044], [0045],

Art Unit: 3731

[0046]). As shown in Figures 13 and 20 below, the lumen increases in diameter toward the distal open tip.



Although only a portion of the lumen of Figueroa increases in diameter toward the distal tip, it is the examiner's position that the instant claims are broad enough that a portion of the lumen overlaps the instant claims.

With regard to **claim 3**, shelf segment (29) comprises leading edge (51a) and overlaps the instantly claimed compressor drawer ([0044], Figure 14). The lens (12) is folded and compressed within the shelf segment (29) ([0049]).

With regard to **claims 4 and 5**, Figueroa further discloses the device as comprising a plunger (18) for pushing the IOL lens through the lumen ([0043]). As shown in Figure 1, the outer diameter of the plunger is slightly smaller than the inner diameter of the lumen.

With regard to **claim 6**, it is the examiner's position that the diameter of the lumen is substantially constant from the IOL holding point to the distal open tip (Figure 1).

With regard to **claims 8 and 10**, as shown in Figure 20, the increase of the diameter of the lumen is gradual.

3. **Claims 1 and 3-6** are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf (US 5,800,442).

With regard to **claim 1**, Wolf discloses a device for inserting an IOL into an eye. The device comprises a body (14) having an internal lumen opening in a distal tip (Figure 1). The body further comprises an opening (17) to receive an IOL lens (column 6, lines 1-9). As shown in Figure 12, the lumen increases in diameter toward the distal tip.

With regard to **claim 3**, lens cartridge (12) comprises a leading edge (74) to facilitate bending and compressing of the IOL lens (column 8, lines 10-19; column 10, lines 20-26; Figure 30). Therefore, the lens cartridge overlaps the instantly claimed compressor drawer.

With regard to **claims 4 and 5**, Wolf further discloses a plunger (16) to engage and slideably push the IOL lens through the lumen (column 10, lines 39-45). As shown in Figures 1 and 24, the outer diameter of the plunger is smaller than the inner diameter of the lumen.

With regard to **claim 6**, the outer diameter of the device is substantially constant along the length of the device (Figure 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 7 and 11-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Figueroa (US 2002/0022881 A1).

Figueroa discloses a device for injecting a foldable IOL lens into an eye wherein the inner lumen increases in diameter. However, Figueroa does not teach wherein the outer diameter of the lumen increase along with the inner lumen or where the inner lumen increase is stepped.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the increase of the inner and outer diameter of the lumen because Applicant has not disclosed that either modification provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the lumen disclosed by Figueroa because the lumen is able to receive an IOL lens. Therefore, it would have been an obvious matter of design choice to modify Figueroa to obtain the invention as specified in the claims.

7. **Claims 7-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf (US 5,800,442).

Wolf discloses a device for injecting a foldable IOL lens into an eye wherein the inner lumen increases in diameter. However, wolf does not teach wherein the outer diameter of the lumen increase along with the inner lumen or where the inner lumen increase is stepped or gradual.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the increase of the inner and outer diameter of the lumen because Applicant has not disclosed that either modification provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the lumen disclosed by Wolf because the lumen is able to receive an IOL lens. Therefore, it would have been an obvious matter of design choice to modify Wolf to obtain the invention as specified in the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3731

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Lang whose telephone number is (571) 272-9057. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/30/2007
Amy T. Lang

ATL


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
6/2/07